



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,944	09/27/2001	Robert A. Dunstan	42390P11892	5051

8791 7590 05/05/2005

BLAKELY SOKOLOFF TAYLOR & ZAFMAN  
12400 WILSHIRE BOULEVARD  
SEVENTH FLOOR  
LOS ANGELES, CA 90025-1030

EXAMINER

PARTON, KEVIN S

ART UNIT	PAPER NUMBER
----------	--------------

2153

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/966,944	DUNSTAN, ROBERT A.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kevin Parton	2153	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

*[Handwritten signature]*

## DETAILED ACTION

### *Remarks*

1. In the applicant's response, it is stated that claims 1-22 are currently pending. However, in the claim listing, claim 15 has been cancelled, as such, claims 1-14, and 16-22 are currently pending and are addressed below.

### *Response to Arguments*

2. Applicant's arguments filed 12/15/2004 have been fully considered but they are not persuasive. Please see the following reasons and the grounds of rejection below.

3. On page 8, paragraph 2, the applicant presents three arguments regarding the deficiency of the reference to Elg (USPN 6,694,354). Specifically, the applicant argues that Elg (USPN 6,694,354):

- a. Fails to teach that the memory device stores a "complete" address for a remote location.
- b. Requires a peripheral type of device whereas the applicant's invention only needs a home network system.
- c. Is inadequate because the applicant's invention does not make use of a plug-n-play protocol.

The argument marked (a) is not persuasive because the definition of a "complete" address is not included in the claim language. As shown in figure 2 of the reference, the address stored includes at least <http://www.ericsson.com>. Because this information alone is enough to contact another machine on the web, it can be considered a "complete" address. Please also note that in the current claims, the

Art Unit: 2153

remote destination is never contacted and the device information is never retrieved. It simply states that the address is provided and the control information is stored there.

The argument marked (b) is not persuasive because no claim limitations preclude the use of the system on peripheral devices. The peripherals of Elg (USPN 6,694,354) are connected to a home network via a host computer; nothing in the claims precludes this type of connection.

The argument marked (c) is not persuasive because the reference to Elg (USPN 6,694,354) does not mention the use of a plug-n-play protocol. The plug-n-play protocol cited by the applicant (specification, paragraph 0017) is UpnP, this is not specified as being used in the reference, nor is any other plug-n-play specific protocol.

4. On page 10, paragraph 1, the applicant argues that the reference to White et al. (USPN 6,301,012) fails to teach determining whether characteristic information for a device is previously stored on a home network system and, if not, retrieving the device's information to achieve plug-n-play capability without plug-n-play protocol. It is unclear which part of the claim the applicant is arguing here since a large portion of the claim limitation has been quoted. However, the reference to White et al. (USPN 6,301,012) in column 3, line 58 – column 4, line 5 clearly states that if a particular characteristic information (driver) for a device is not already registered, it will be obtained, possibly from a "remote" location on the network. Further, again, there is no mention of any plug-n-play protocol in the reference, either in general or specifically such as UpnP.

5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (page 12, paragraph 4 – page

Art Unit: 2153

13, paragraph 1), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

6. All further arguments are not persuasive for the same reasons shown above.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Regarding claims 1 and 6, the claim specifies that "control and characteristic" information is stored at a remote location and that the electronic device "achieves plug-n-play capability". The claims never specify that the information at the remote location is obtained and provided to the device in order for it to achieve the new capability. It simply states that the information exists and that the device is configured. As written, the claims are not in agreement with the applicant's specification nor do they describe an operable system.

10. Claims 2-5 and 7-12 are rejected because they are dependent on the rejected base claims.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Elg (USPN 6,694,354).

13. Regarding claim 1, Elg (USPN 6,694,354) teaches a system comprising an electronic device for coupling to a home network system (figure 1); the electronic device having a memory device, the memory device contains a remote location's complete address (figure 2; column 3, lines 2-4), wherein one of control and characteristic information for the electronic device is stored at a remote location from the electronic device, wherein the electronic device achieves plug-n-play capability without plug-n-play protocol (column 3, lines 17-25).

14. Regarding claims 2 and 8, Elg (USPN 6,694,354) teaches all the limitations as applied to claims 1 and 6, respectively. He further teaches means wherein the complete address includes one of a complete uniform resource locator (URL) and a complete Internet protocol (IP) address (figure 2; column 3, lines 2-4).

15. Regarding claims 3 and 9, Elg (USPN 6,694,354) teaches all the limitations as applied to claims 2 and 8, respectively. He further teaches means wherein the

electronic device's characteristics and control information is maintained at the remote location (column 3, lines 17-25).

16. Regarding claims 4 and 10, Elg (USPN 6,694,354) teaches all the limitations as applied to claims 1 and 6, respectively. He further teaches means wherein the electronic device is a consumer electronic (CE) device (column 2, lines 60-65).

17. Regarding claim 5, Elg (USPN 6,694,354) teaches all the limitations as applied to claim 1. He further teaches means wherein the electronic device transmits the complete device identification on a device specific bus when coupled to the device specific bus (column 3, lines 1-4).

18. Regarding claim 6, Elg (USPN 6,694,354) teaches a system comprising:

- a. A plurality of electronic devices each including a memory device, each of the memory devices contain a remote location's complete address wherein one of control and characteristic information for the electronic device is stored at a remote location from each of the plurality of electronic devices (figure 1; figure 2; column 3, lines 2-4, 17-25).
- b. A plurality of device specific buses coupled specifically to the plurality of electronic devices (figure 1).
- c. A plurality of device specific network bridge devices coupled specifically to the plurality of device specific buses and a home network (figure 1, column 2, lines 56-57; column 3, lines 17-20).

Art Unit: 2153

- d. A device for communicating with a remote network, wherein each of the electronic devices achieve plug-n-play capability without plug-n-play protocol (column 3, lines 17-20).

19. Regarding claim 7, Elg (USPN 6,694,354) teaches all the limitations as applied to claim 6. He further teaches:

- a. A central processing device coupled to the home network (figure 1; column 2, lines 55-60). Please note that the host computer is a central processing device on the home network.
- b. A central memory device coupled to the central processing device (figure 1; column 2, lines 55-60).
- c. A display coupled to the central processing device (figure 1; column 2, lines 55-60).

20. Regarding claim 11, Elg (USPN 6,694,354) teaches all the limitations as applied to claim 6. He further teaches means wherein the remote network is one of the Internet and an Intranet (column 3, lines 17-20).

21. Regarding claim 12, Elg (USPN 6,694,354) teaches all the limitations as applied to claim 11. He further teaches means wherein each of the device's characteristics and control information is retrieved from a specific remote location upon coupling the device to its device specific bus (column 3, lines 1-4).

22. Claims 13, 14, 18, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by White et al. (USPN 6,301,012).



Art Unit: 2153

23. Regarding claims 13 and 18, White et al. (USPN 6,301,012) teaches a system with means for:

- a. Generating a request for a device's remote location complete address (column 3, lines 39-57).
- b. Receiving the requested device's complete address from the device (column 3, lines 39-57).
- c. Determining whether characteristic information for the device is previously stored on a home network system (column 3, lines 58-61).
- d. Communicating with the remote location if the device's characteristic information is not previously stored on the home network system (column 3, lines 60-65).
- e. Retrieving the device's characteristic information if the characteristic information is not previously stored on the home network system (column 3, lines 65-66).
- f. Storing the characteristic information not previously stored on the home network system (column 3, line 65 – column 4, line 5).
- g. Controlling the device on the home network system wherein the device achieves plug-n-play capability without plug-n-play protocol (column 3, lines 47-57).

24. Regarding claims 14 and 19, White et al. (USPN 6,301,012) teaches all the limitations as applied to claims 13 and 18, respectively. They further teach means for:

- a. Using the device's characteristic information to control the device  
(column 3, lines 54-56).
- b. Determining whether the stored characteristic information needs to be  
updated (column 3, lines 58-62).
- c. Replacing the stored characteristic information with new characteristic  
information if the stored characteristic information needs to be updated  
(column 3, lines 62-67).

***Claim Rejections - 35 USC § 103***

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 16-17, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (USPN 6,301,012) in view of Elg (USPN 6,694,354).

27. Regarding claim 20, although the system disclosed by White et al. (USPN 6,301,012) (as applied to claim 18) shows substantial features of the claimed invention, it fails to disclose means wherein the device's identification information is a remote location's complete destination information.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by White et al. (USPN 6,301,012) as evidenced by Elg (USPN 6,694,354).

In an analogous art, Elg (USPN 6,694,354) discloses a system for the integration of peripheral devices wherein the device's identification information is a remote location's complete destination information (column 3, lines 2-4).

Given the teaching of Elg (USPN 6,694,354), it would be obvious to one of ordinary skill in the art to modify the system of White et al. (USPN 6,301,012) by providing the destination location in the device's identification information. This benefits the system by allowing it to quickly access remote information without a secondary lookup.

28. Regarding claims 16 and 21, although the system disclosed by White et al. (USPN 6,301,012) (as applied to claims 15 and 20, respectively) shows substantial features of the claimed invention, it fails to disclose means wherein the remote location's complete address is one of a complete uniform resource locator (URL) and a complete Internet Protocol (IP) address.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by White et al. (USPN 6,301,012) as evidenced by Elg (USPN 6,694,354).

In an analogous art, Elg (USPN 6,694,354) discloses a system for the integration of peripheral devices wherein the remote location's complete address is one of a complete uniform resource locator (URL) and a complete Internet Protocol (IP) address (column 3, lines 2-4).

Given the teaching of Elg (USPN 6,694,354), it would be obvious to one of ordinary skill in the art to modify the system of White et al. (USPN 6,301,012) by

Art Unit: 2153

providing a URL or IP address as the location of the remote provider. This benefits the system by giving it an immediate web address that can be accessed with no further search on an Intranet or on the Internet.

29. Regarding claims 17 and 22, White et al. (USPN 6,301,012) teaches all the limitations as applied to claims 13 and 18, respectively. They further teach means for displaying information on a display device (column 4, lines 6-8).

### ***Conclusion***

30. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Parton whose telephone number is (571)272-3958. The examiner can normally be reached on M-F 8:00AM - 4:30PM.


Art Unit: 2153

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin Parton  
Examiner  
Art Unit 2153

ksp



GLENTON B. BURGESS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100